

**FAX**

Date March 28, 2002

Number of pages including cover sheet 17

TO: Examiner Uyen T Le  
Art Unit 2171Phone 703-305-4134  
Fax Phone 703-746-7238FROM: William G. Lane  
William G. Lane, Inc., P.C.  
16485 Laguna Canyon Road  
Suite 250  
Irvine, CA 92618Phone 949-585-0348  
Fax Phone 949-585-0494REMARKS: ☐ Urgent ☐ For your Review ☐ Reply ASAP ☐ Please Comment

Dear Ms. Le:

The return post card for the amendment filed on March 4<sup>th</sup> has not been posted in the file. My secretary is out ill and I don't know if it has been received. I checked the bank and found that the check in payment of the extension fee cleared my bank on March 15<sup>th</sup>. The response was sent with a signed mailing certificate.

Best regards,

William G. Lane

P.S.  
I found the post card in my secretary's files. It is stamped March 12, 2002



## \*\*\*\*NOTICE\*\*\*\*

The information contained in this facsimile transmission is intended only for the individual to whom or entity to which it is addressed. It may also contain privileged, confidential, attorney work product or trade secret information which is protected by law. If the reader of this message is not the intended recipient, or an employee or agent responsible for delivering the message to the addressee, the reader is hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone and return the original message to us at the address above via the U.S. Postal Service. We will reimburse you for any reasonable expense (including postage) for the return of the original message.

Client: CMS PERIPHERALS, INC.  
Inventor(s): ERIC ROBINSON  
Title: AUTOMATIC BACKUP SYSTEM

Atty Dkt No.: C013-1002  
Serial No.: 09/416,675  
Date Filed: October 12, 1999

The Assistant Commissioner for Patents acknowledges receipt of the following listed items on the date stamped hereon:

1. Transmittal
2. Amendment and Request for EOT
3. Transmittal of Corrected Drawings
4. two (2) sheets corrected informal drawings
5. Check in amt of \$200 for 2-mo EOT
6. Cert. of Mailing

Date Mailed: March 4, 2002



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Date Mailed: March 4, 2002

**WILLIAM G. LANE, INC., P.C.**  
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PH. 949-585-0348

**WELLS FARGO BANK**  
16-24-1220

03/04/2002

4516

PAY TO THE ORDER OF Assistant Commissioner of Patents

\$ \*\*200.00

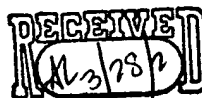
Two Hundred and 00/100

DOLLARS

MEMO

SN 09/416,675; C013-1002

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Attorney Docket: C013-1002

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric Robinson  
 Serial No.: 09/416,675  
 Date Filed: October 12, 1999  
 For: AUTOMATIC BACKUP SYSTEM

Examiner: Uyen Le  
 Group Art Unit: 2171

Assistant Commissioner for Patents  
 Washington, DC 20231

## Certificate of Mailing

I hereby certify that this document, together with any described as being attached or enclosed, is being deposited with the United States Postal Service as first class mail, postage fully prepaid, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on March 4, 2002.

Dated: March 4, 2002
  
 William G. Lane

TRANSMITTAL OF  
 AMENDMENT AND REQUEST FOR EXTENSION OF TIME

Dear Sir:

Enclosed are the following documents in response to the Office Action mailed October 2, 2001:

Amendment and Request for Two-Month Extension of Time;  
 Transmittal of Corrected Drawings;  
 Two (2) sheets corrected informal drawings;  
 Check in amount of \$200, fee for two-month extension;  
 Certificate of Mailing; and  
 Post card

The fees for claims and the extension have been calculated as follows for a small entity:

	Claims Remaining	Highest No. Previously Paid	No. Extra	Rate (Small Entity)	Additional Fee Due
Total Claims	18	20	0	x \$9 =	\$ 0.00
Total Independent Claims	02	03	0	x \$42 =	0.00
Total for Claims					\$000.00
2-Mo. Ext. Fee					200.00
TOTAL DUE					\$200.00

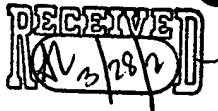
Applicant qualifies as a small entity.

Respectfully submitted,

Date: March 4, 2002
  
 William G. Lane, Reg. No. 24,761  
 Attorney of Record

WILLIAM G. LANE, INC., P.C.  
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 Fax. 949-585-0494

Official



Attorney Docket: C013-1002

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric Robinson  
Serial No.: 09/416,675  
Date Filed: October 12, 1999  
For: AUTOMATIC BACKUP SYSTEM

Examiner: Uyen Le  
Group Art Unit: 2171

Assistant Commissioner for Patents  
Attention: Official Draftsperson  
Washington, DC 20231

## Certificate of Mailing

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Dated: March 4, 2002  
William G. Lane

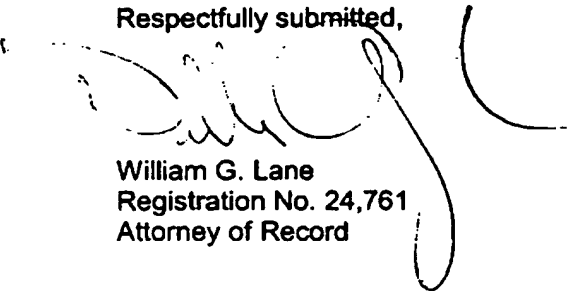
## TRANSMITTAL OF CORRECTED DRAWINGS

Dear Sir:

Enclosed are 2 sheets of corrected informal drawings which include corrections required by the Notice of Draftsperson's Patent Drawing Review. The encircled box of drawing numbers 2A, 2B, 2C, 2D, 2E contains a lengthy legend (See the second sheet) that will require an enlarged box. The final drawing will contain the legends in red and the drawing numbers in red. However because of space requirements, the final drawing may have to be spread over two sheets.

The information inserted in the drawing is supported by the specification as filed. See pages 11, 12, and 15-17 of the specification.

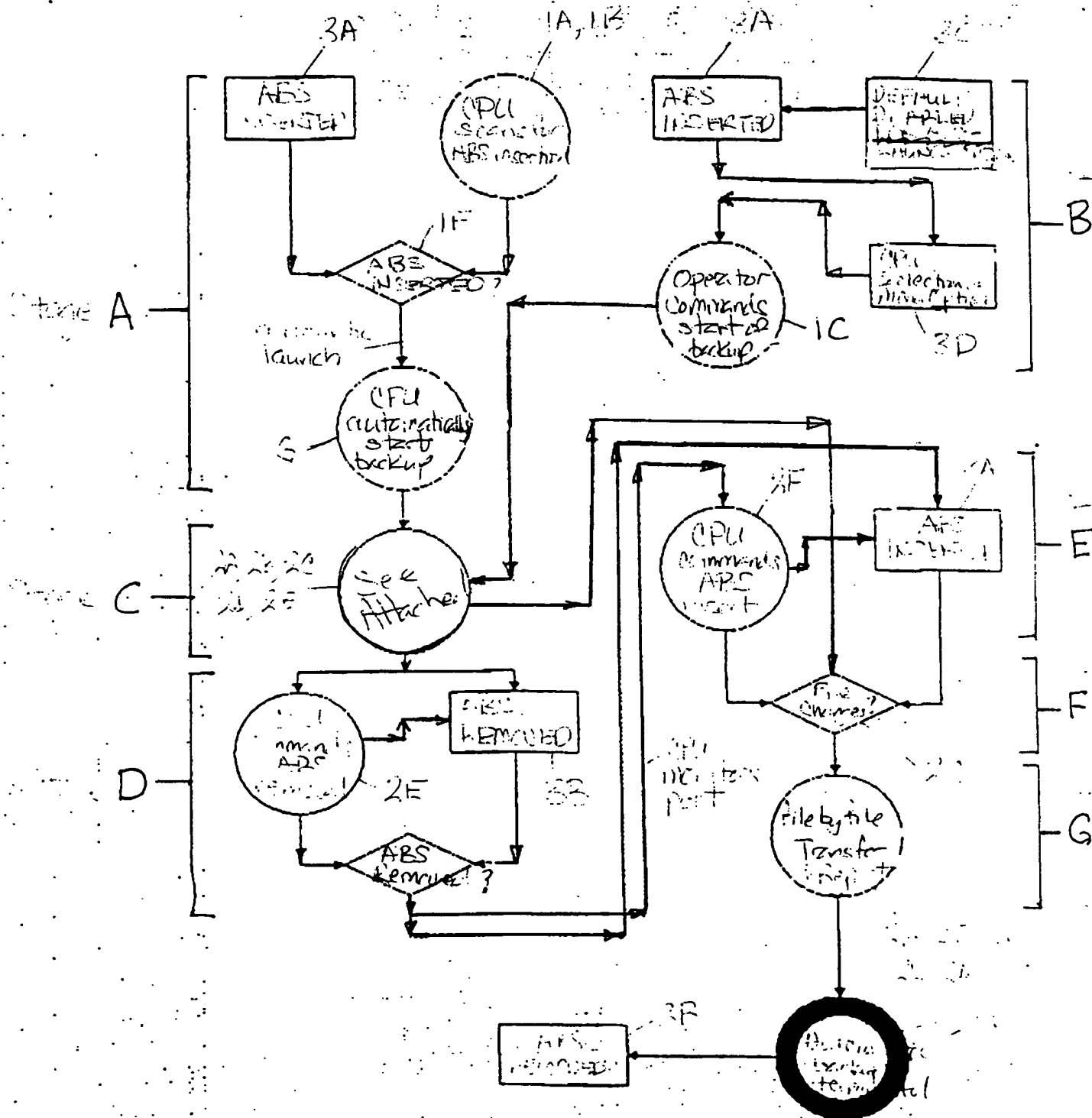
Respectfully submitted,

  
William G. Lane  
Registration No. 24,761  
Attorney of Record

Serial No. 29/074,321  
Page 2

**Direct all correspondence to:**

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16485 Laguna Canyon Road, #250  
Irvine, California 92618  
Tel. 949-585-0348  
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Attorney Docket: C013-1002

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric Robinson  
Serial No.: 09/416,675  
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For: AUTOMATIC BACKUP SYSTEM

Examiner: Uyen Le  
Group Art Unit: 2171

Assistant Commissioner for Patents  
Washington, DC 20231

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Dated: March 4, 2002

William G. Lane

## AMENDMENT AND REQUEST FOR EXTENSION OF TIME

Dear Sir:

This amendment is filed in response to the Final Office Action mailed on October 2, 2001. Response was due January 2, 2002. A two-month extension of time is requested, that is until Monday, March 4, 2002, to file the response. The two-month extension fee of \$200.00 (small entity) is enclosed. Kindly amend the application as follows:

IN THE CLAIMS

Cancel Claims 21-40 without prejudice and substitute.

Add new Claims 41-58.

41. A method of automatically backing up data from a computer comprising:  
connecting an ABS unit designated as a data backup to a PCMCIA port on a computer;  
the computer scanning for devices connected to its PCMCIA port;  
the computer recognizing the ABS unit inserted into its PCMCIA port;  
the computer then automatically launching its automatic backup procedure comprising;  
the computer scanning all files on its source drives and comparing the files on the ABS unit for date and time changes to identify file changes;

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the computer comparing space available on the ABS unit and comparing it to the space required to back up file changes on the source drive in the computer; and

the computer making a file-by-file transfer of the file changes on the source drive to the ABS unit, if the computer finds enough space available on the ABS unit for the file changes.

42. The method according to Claim 41 wherein the computer reports status of backup at the end of the file-by-file transfer to the ABS unit.

43. The method according to Claim 41 wherein the computer writes the status of the file-by-file transfer to the ABS unit at the end of backup to the source drives.

44. The method according to Claim 43 wherein the computer reviews the status of the file-by-file transfer at the end of the last backup when it scans all files on the source drives and compares the files on the ABS unit for date and time changes.

45. The method according to Claim 43 wherein the computer terminates the backup after completion of writing the status of the file-by-file transfer to the ABS unit at the completion of the backup.

46. The method according to Claim 41 wherein the computer scans its registry for an automatic backup launch file when the computer recognizes the ABS unit connected to its PCMCIA port.

47. The method according to Claim 41 wherein the computer requests a password after connection of the ABS unit to the computer's PCMCIA port; a password is

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entered into the computer, the computer translates the backup procedure password from the registry and compares it to the entered password and the computer transfers passwords to the ABS unit connected to its PCMCIA port wherein the ABS unit compares password in its registry to the entered password; and upon the computer verifying the authenticity of the entered password, the computer to launches the backup procedure, and when the ABS unit authenticates the operator-entered password authorizes entry of the computer into its files.

48. The method according to Claim 41 wherein the computer requests a password; a password is entered into the computer; the computer translates the password from its registry; and the computer transfers the operator-entered password to the ABS unit connected to its PCMCIA port.

49. The method according to Claim 48 wherein the computer after recognizing the ABS unit connected to its PCMCIA port and requests a password from the ABS unit; the ABS unit furnishes the password to the computer; the computer translates the password from the registry; and the computer authenticates the password prior to launching the automatic backup procedure.

50. The method according to Claim 41 wherein the computer requests the operator for a selection of options after the computer recognizes the ABS unit connected to its PCMCIA port and before launching the backup procedure.

51. The method according to Claim 41 wherein the computer scans its registry for option selections prior to launching the backup procedure.

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52. The method according to Claim 41 wherein the computer requests removal of the ABS unit from its PCMCIA port.

53. The method according to Claim 52 wherein the computer requests insertion of the ABS unit to its PCMCIA port.

54. The method according to Claim 41 wherein the ABS unit is disconnected from the computer PCMCIA port prior to completion of the file-by-file transfer; and the computer requests connection of the ABS unit to its PCMCIA port.

55. The method according to Claim 41 wherein the computer compares the space available on the ABS unit to the file changes on the source drives and finds there is insufficient space available to backup the file changes and monitors that there insufficient available space on the ABS unit to complete the backup procedure.

56. The method according to Claim 55 wherein the ABS unit is removed from the PCMCIA port, and replaced with a new ABS unit having sufficient available space to backup the computer source drive.

57. The method according to Claim 55 wherein the computer shuts down the backup procedure when it finds there is insufficient available space available on the ABS unit for the file changes.

58. An automatic backup method comprising the steps of:

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inserting an automatic back up device into a port of a computer;  
the computer scanning and detecting the automatic backup device connected to the port;  
the computer identifying the automatic backup device;  
the computer then automatically launching a backup procedure to backup its files onto the automatic backup device; and  
the computer automatically closing down the backup procedure at the completion of the backup of the computer files onto the automatic backup device.

#### **REMARKS**

New claims 41-58 are in the application, Claims 21-40 having been cancelled without prejudice. All the new claims are virtually identical to canceled Claims 21-40 except as set forth below. Claims 26 and 27 were not carried over to the new claims. With respect to Claim 41, the term "then automatically" has been added to the fifth line of Claim 21 to create claim 41. Claims 42-57 are identical to Claims 22-25 and 28-39, except for dependency which had to be renumbered. The dependency of all the new claims remains identical to the dependency of the canceled claims, except for new claim 49 [31] which has been made dependent upon new claim 48 [30]. Canceled claim 31 was incorrectly made dependent upon claim 21; it should have been dependent upon claim 30. With regard to new claim 58, this claim is identical to Claim 40, except that on the sixth line of new claim 58, the term " then" has been added before the term "automatically."

The amendment to the claims is fully supported by the specification as filed. See, for example, page 4, lines 14-22 et seq. The claims were amended to further meet a requirement made by the Examiner. The amended claims add no new matter to the application.

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Atty. Docket No. C013-1002

#### THE OFFICE ACTION

On page 2, paragraph 3, of the Action, the Examiner contends that the "...limitation of automatically launching the backup operation by insertion alone of the backup device is not reflected in the claim language. Claims 21 [41] and 40 [58] merely require a computer to launch its automatic backup procedure once it recognizes that the automatic backup system (ABS) is inserted into the PCMCIA port. Claims 21 and 40 do not exclude scheduled automatic backup." The applicant traverses this allegation because Claims 21 and 40 clearly specified that the computer upon recognizing the ABS unit inserted into its PCMCIA port, launched its automatic backup procedure which comprised the steps set forth in Claims 21 and 40.

To advance prosecution of this application, Applicant has amended Claims 21 and 40 into new Claims 41 and 58, respectively, to further emphasize that the computer **then automatically** launches its automatic backup procedure when a ABS unit has been inserted in a port and the computer recognizes the ABS unit inserted into its PCMCIA port or other port. This language clearly excludes scheduled automatic backup. The computer automatically launches, it does not wait for a scheduled date or time as Makinen teaches.

The Action on pages 2 and 3 further states that "Makinen explicitly shows a method of automatically backing up data from a computer (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include connecting an ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup of data as taught by Makinen."

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Makinen does not teach the automatic backup system of the present invention. Makinen states in the abstract, "A system and method for automatically archiving data from a computer system to a backup system. **The system provides a scheduler, connected to an automated backup mechanism for scheduling when full backups are performed and when incremental backups are performed.**" (emphasizes added) Nowhere within Makinen is it taught that backup can be accomplished or should be accomplished without a scheduler or a scheduling step. In addition, neither Makinen or Harari teach that the backup should commence upon insertion and recognition of the backup device in the port. The teaching of Makinen is clear: the backup does not commence until the scheduled day and the time requirements are met. There is no scheduling step in Claims 41-58.

### **35 USC § 103 Rejection**

Claims 21-40 are rejected under 35 USC 103(a) as being unpatentable over Makinen et al. (US 5,758,067) of record, in view of Harari et al. (US 5,887,145). With regard to Claim 21, the Action alleges that "Makinen discloses a method of automatically backing up data from a computer, (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (column 3, lines 20-23, and column 9, lines 18-30). Therefore it would have been obvious to one of ordinary skill in the art to include connecting an ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup data as taught by Makinen. Furthermore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning for devices connected to the PCMCIA port, recognizing the ABS unit inserted to the PCMCIA port, launching the automatic backup procedure, scanning all source files and comparing



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to the files on the ABS for changes, determining space required for backing up data and space available on the ABS, making a file-by-file transfer of the changes to the ABS unit if space is available on the ABS since the computer has to recognize the presence of the ABS before launching the automatic backup and only files that have changed need be backed up again on the ABS, provided space is available on the ABS.

No authority or evidence is cited to show the above recited steps or the combinations. But more significantly, the art does not show that upon "the computer recognizing the ABS unit inserted into its PCMCIA port, the computer then automatically launching its automatic backup procedure..." (Claim 41, lines 4 and 5). These steps are not taught or suggested by Makinen and Harari. Any combination of Makinen or Harari does not realize these steps. Even hindsight reconstruction of the references will not yield these steps because these key steps of the claims are completely missing from the references.

With regard to Claims 22-39 which were ultimately dependent upon Claim 21, the Office Action contends that it would have been obvious to one of ordinary skill in the art to carry out the recited step of each claim. No authority or evidence was presented to show the recited step is known or to show that it would have been obvious to combine the recited step with Claim 21. The applicant traverses the rejection of Claims 22-25 and 28-39 as they are applied to identical new Claims 42-57.

In the case of *In re Lee* (61 USPQ 2d 1430). Decided on January 18, 2002, the U.S. Court of Appeals for the Federal Circuit, took up the issue whether claims can be properly rejected on conclusions of the basic knowledge or common sense of one of ordinary skilled in the art. The Court quoted from *In re Fritch* that " '...the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious' (citation omitted)" 61 USPQ2d 1434. The court also quoted from *In re Zurko* that " 'deficiencies of the cited references cannot be remedied by the Board's general

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Atty. Docket No. C013-1002

conclusions about what is basic knowledge or common sense.' (citation omitted)" at 1434-44. Thus the court fully rejected the "basic knowledge" or "commonsense" type of rejection where there is no evidence supporting such basic knowledge or commonsense. The court required that evidence and authority be shown to support that the combination and missing element of a rejected claim are obvious to one of ordinary skill. The cited prior art does not teach the steps nor the combinations set forth in Claims 22-39. Since there is no evidence or authority for the steps and combination of these claims, the rejection of Claims 22-39 is clearly unsupported and improper.

Similarly, the rejection to Claim 40 does not meet the standards set forth in the *In re Lee* case. It is admitted in the Action that Makinen does not specifically show that the system performs all the claimed operations of Claim 40. But the Action states that "it is well known in the art to connect a backup system to a computer as shown by Harari (page reference omitted). The Action then concludes that it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning and detecting a device connected to a port of the computer, identifying the automatic backup system, automatically launching a backup procedure while implementing the system of Makinen in order to backup file changes to a system connected to the computer through a port depending on the size of the backup data as taught by Harari to avoid operator's intervention. Furthermore, since the backup system is inserted to a port of the computer, it would have been obvious to one of ordinary skill in the art to make the computer automatically close the backup procedure once the backup had been completed in order to disconnect the backup system from the computer system."

No authority or evidence is cited to show the above-mentioned steps or combination. In addition a significant deficiency is the fact that neither reference teaches or suggests commencing backup by insertion of the backup device and recognition of the device in a port by the computer. As shown above these steps are not taught by the references, and there is not evidence or

Serial No.: 09/416,675  
Atty. Docket No. C013-1002

authority to show that these steps would have been obvious to one of ordinary skill. The rejection of Claim 40 is clearly unsupported and improper under the dictates of the In re Lee case.

#### DRAWING

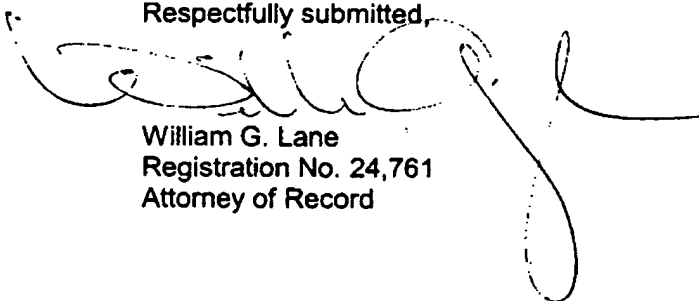
A proposed amended drawing has been prepared (copy attached) and has been submitted to the chief draftsman for review and approval.

#### CONCLUSION

In conclusion, it is respectfully submitted that the new claims 41-58 are clearly patentable over Makinen and Harari, either alone or in combination. It would not have been obvious to one of ordinary skilled in the art to take the backup system of Makinen and modify it so that backup was initiated on the insertion of a backup unit into a computer because these steps are not taught, suggested, even hinted at, in either Makinen or Harari.

A favorably action is solicited.

Respectfully submitted,



William G. Lane  
Registration No. 24,761  
Attorney of Record

Date: March 4, 2002

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